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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,445	10/21/2003	Burney J. Latiolais JR.	Frank's Int.-101	3726

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THE MATTHEWS FIRM  
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HOUSTON, TX 77057

EXAMINER
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CHIN, PAUL T

ART UNIT	PAPER NUMBER
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3652

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,445

Applicant(s)

BURNEY ET AL.

Examiner

PAUL T. CHIN

Art Unit

3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's arguments filed May 17, 2005, have been fully considered but they are not persuasive. Therefore, THIS ACTION IS MADE FINAL.

#### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "saw tooth diameter of the band 100" (Claims 2 and 9) must be shown or the feature(s) canceled from the claim(s). Note that figure 13B must show the "saw tooth" for consistency with the figure 10. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mosing et al. (5,819,805).

Mosing et al. (5,819,805) discloses a ring device comprising a cylindrical ring (111) sized to slide over the exterior surface of the box end of said tubular, said ring having a first end, a second end, and a shoulder ring having upper and lower surfaces at its first end and a sidewall between said second end and said shoulder end, said sidewall having a circumferential groove (see Fig. 14) about its interior surface, and a second groove \*106) through said sidewall for accessing said circumferential groove; a split-ring metal band (104) having first and second ends positioned within said circumferential groove having a latch mechanism (Fig. 14) connected between said first and second ends of said band, said latch mechanism having a handle (123) accessible through said second groove which, when activated, reduces the internal diameter of said band.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2,3,9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosing et al. (5,819,805) in view of Clark (4,349,048).

Mosing et al. (5,819,805), as presented in section 4 above, does not show a saw tooth inner diameter for gripping the external surfaces of said oilfield tubular. However, Clark (4,349,048) shows a saw tooth (102) inner diameter of a ring for gripping the external surfaces of said oilfield tubular. Accordingly, it would have been obvious to those skilled in the art to provide a saw tooth on the inner diameter of the cylinder ring of Mosing et al. (5,819,805) as taught by Clark (4,349,048) to frictionally grip the outer surface of the tubular.

7. Claims 4-7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosing et al. (5,819,805) and Clark (4,349,048), as applied to claims 1 and 8 above, and further in view of Lundquist (4,018,468).

The Mosing et al. (5,819,805), as presented in sections 4 and 6 above, does not show a second split ring and a bevel edge to align with the groove of the cylinder ring. However, Lundquist (4,018,468) shows a split ring (Fig. 3) with a bevel edge (5) to grip a rounded object. Accordingly, it would have been obvious to those skilled in the art provide a second split ring with a bevel edge within the groove of the first ring of the modified Mosing et al. (5,819,805) as taught by Lundquist (4,018,468) to provide an extra ring to firmly grip and protect the tubular.

#### ***Response to Arguments***

8. Applicant's arguments filed May 17, 2005, have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "for raising and/or lowering an oilfield tubular having a box end and a pin end" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where **it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.** See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that "Mosing et al. is for a thread protector, not for use as a load ring" (page 2), **a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). It is pointed out that the structure of Mosing's device is similar to the application and the reference is capable of performing the intended use, i.e. "sized to slide over the exterior surface of a tubular", "to grip an exterior surface of the tubular" and the "deactivation of the handle causes the band to release the exterior surface".

Applicant also argues that "a load lift ring enables a tubular to be picked up or lowered, which may weigh several thousand pounds" (the last paragraph of page 2) and "the

apparatus of claims 1-14 is used as a load lift ring" (1<sup>st</sup> paragraph of page 3). The argument is not persuasive because applicant does not recite "a load lift ring" in the claim (note that there is no "lift" recited in the claims, as applicant argues) and "the tubular weighing several thousand pounds" in the body of the claims. Mosing's device is capable of performing the intended use, i.e. "sized to slide over the exterior surface of a tubular", "to substantially grip an exterior surface of the tubular" and the "deactivation of the handle causes the band to release the exterior surface".

In response to applicant's argument that "Mosing et al. (5,819,805) is nonanalogous art", it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Mosing's device discloses a cylinder ring and a split-ring metal band being sized to slide over an exterior surface of a tubular, to substantially grip an exterior surface of the tubular, and the deactivation of the handle causes the band to release the exterior surface.

Applicant continues to argue that "Merlin Lundquist is not related to a lifting ring, generally referred to a load ring, which can be mounted on a very heavy oil field tubular which weighs several thousand pounds" (3<sup>rd</sup> paragraph of page 3). The argument is incorrect because applicant does not positively recite "a lifting ring" nor "a load ring which can be mounted on a very heavy oil field tubular which weighs several thousand pounds" in the body of the claims. Note that there are many tubular used in the oil field industries and not all of the tubular weigh several thousand pounds, as applicant argues.

Merlin Lundquist's device discloses a split circular ring (Fig. 3) with a bevel edge (5) to grip a rounded object. Mosing's device discloses a cylinder ring and a split-ring metal band being sized to slide over an exterior surface of a tubular, to substantially grip an exterior surface of the tubular, and the deactivation of the handle causes the band to release the exterior surface. To those skilled in the art would provide a split circular ring (Fig. 3) with a bevel edge (5) of Merlin Lundquist's device on the cylinder ring and a split-ring metal band of Mosing's device to provide an extra ring to firmly grip and protect the tubular.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hall (5,368,074) discloses a split ring as shown in figures 3-5.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **PAUL T. CHIN** whose telephone number is (571) 272-6922. The examiner can normally be reached on **MON-THURS (7:30 -6:00 PM)**.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DEAN J. KRAMER  
PRIMARY EXAMINER 2/8/05